

REMARKS

Claims 1 to 52 were pending in the application at the time of examination. Claims 1 to 52 stand rejected as anticipated.

Applicant(s) have amended the description to properly reflect the status of the U.S. Patent Applications cited therein.

Prior to considering the anticipation rejections Applicant respectfully notes, for example, that the preamble of Claim 1 recites:

A method for operating a smart card to provide an application identifier (AID) for an application on the smart card

Thus, the preamble makes clear that a single smart card is being operated to provide an AID for an application on the smart card. Thus, the operations are with respect to the smart card. The preamble helps give a specific meaning to the claim elements and so should be considered in the anticipation rejection. In particular, the MPEP directs:

"[A] claim preamble has the import that the claim as a whole suggests for it." *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995). "If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is 'necessary to give life, meaning, and vitality' to the claim, then the claim preamble should be construed as if in the balance of the claim." (Emphasis added)

MPEP 2111.02, 8th Ed., Rev. 3, p-2100-51 (August 2005). Thus, the preamble should be construed as if in the balance of the claim, because the elements of Claim 1 take on a particular meaning when so construed. Despite the clear meaning of the preamble, the rejection relies on two smart cards.

To avoid discussions on whether Applicant is requesting the Examiner to read limitations into the claims, Applicant has amended Claim 1 to explicitly recite in the body of the claim that the actions are on the smart card, which should be clear in view of the preamble. Accordingly, Applicant respectfully submits that the amendment should not affect the patentability of the claim.

Similar amendments have been made to Claims 20, 33, and 34 and so the above comments with respect to Claim 1 are incorporated herein by reference.

Claims 1 to 52 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,976,635, hereinafter referred to as Ashizawa.

Applicant respectfully traverses the anticipation rejection of Claim 1. Applicant respectfully notes that Claim 1 recites an application identifier (AID). An AID is a specific element as defined in the specification:

[0012] Associated with each applet on smart card 102 is an Application Identifier (AID). The AID is a byte string up to 16 bytes long, whose format is defined by International Standard ISO/IEC 7816-5. Thus according to this standard, the first 5 bytes of the AID represent the registered application provider identifier (RID) and have a value allocated by ISO or one of its member bodies. The RID generally indicates the merchant or other entity involved with operating the applet, hereinafter referred to as the RID operator. The RID operator is generally responsible for the back office program 130, and is depicted as application/RID operator 131 in FIG. 1. The last 11 bytes of the RID constitute the proprietary application identifier extension (PIX). The PIX is determined by the RID operator 131, and can be used to store a reference number or other information associated with the applet. (Emphasis added)

An AID is not some general attribute, but a specific thing. Ashizawa uses the exact same element, "AID." For example,

In order to realize the above-mentioned service, an example of various kinds of data stored in the IC card are shown in the following. For example, a card ID of an IC card, a card holder ID (inherent to the holder), AID (Application Identifier), the manufacturer's name of an application, the issuer's name of an application: RID (Registered Application Provider Identifier), the card manufacturer's ID, the name of a card issuer, the ID of a card issuer, etc. can be cited

Ashizawa, Col. 6, lines 37 to 45.

(1A) AP name, AP card holder ID, ID (AID) etc.

Ashizawa, Col. 7, lines 8 to 9.

Further it is necessary to specify an application concerning the execution of a service for the execution of services according to the present invention. For the designation the name of a card application or the discrimination number of a card application (AID: application identifier), etc. are used.

Ashizawa, Col. 7, lines 51 to 55.

Further after a card is specified, it is necessary to designate an application concerning a service to be executed. For the above-mentioned designation, the name of a card application or the discrimination number AID, etc. are used.

Ashizawa, Col. 8, lines 52 to 55.

A second mode of the present invention is that the information for designating an application which operates in association being mentioned in the above mode uses at least one out of the following group of information: a card ID of the IC card concerned, a card holder ID, an AID (application identifier), the names of the manufacturer and the issuer of an application, a RID (registered application provider identifier), the names of manufacturer and issuer of a card, and an issuer ID.

Ashizawa, Col. 13, lines 28 to 36.

The above-mentioned attribute information of an IC-card applications means the following: a public key of an IC card application, the name or AID (application identifier) of an IC card application, the name or ID of the manufacturer of an IC card application, the name or RID (registered application provider identifier) of an IC-card-application issuer, etc. The attribute information of an IC-card application uses a designated number of pieces of the attribute information in correspondence to the contents of a service.

Ashizawa, Col. 16, lines 59 to 63.

a name or ID of an IC-card application, that is called AID (application identifier)

Ashizawa, Col. 25, lines 17 and 18.

the name or ID of an IC-card application, AID (application identifier)

Ashizawa, Col. 29, lines 32 and 33.

Thus, both the prior art and the instant application use an "application identifier (AID)." In particular, Ashizawa consistently uses "AID," where the letters are all caps to represent the application identifier. The reason is that "AID" has a specific meaning in the art. Applicants note that the Examiner is permitted to interpret the claims broadly, but the MPEP puts specific limits on that breadth. Specifically,

CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be "given *>their< broadest reasonable interpretation consistent with the specification."

MPEP § 2111 8th Ed. Rev. 3, p 2100-46 (August 2005).

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.

MPEP § 2111 8th Ed. Rev. 3, p 2100-47 (August 2005).

Thus, both the prior art and the specification define an application identifier as being used to identify an application. The specification goes further and gives an explicit definition as quoted above. The MPEP also directs:

Where an explicit definition is provided by the applicant for a term, that definition will control interpretation of the term as it is used in the claim.

MPEP § 2106 C., 8th Ed. Rev. 3, p 2100-8 (August 2005).

Accordingly, the rejection must show that Ashizawa teaches that the AID of Ashizawa has two components. The rejection has failed to cite any teaching in Ashizawa that the "AID" of has two components in the configuration recited in Claim 1. This alone is sufficient to overcome the anticipation rejection. The MPEP requires:

TO ANTICIPATE A CLAIM, THE REFERENCE MUST TEACH EVERY ELEMENT OF THE CLAIM

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." < "The identical invention must be shown in as complete detail as is contained in the . . . claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required.

MPEP § 2131, 8th Ed., Rev. 3, p. 2100-76 (August 2005). It is noted that this directive stated the claim element "must be" shown in as complete detail and arranged as required by the claim.

In all the teachings concerning an AID that were quoted above, there is no mention of the AID having two components in different locations. To the extent that the rejection provides an alternative interpretation concerning the AID, Ashizawa does not support that interpretation when the MPEP requirements quoted above are followed.

In addition, the fact that the rejection relies on a second card is a further demonstration that the rejection is not well founded. Also, there has been no showing in Ashizawa of an AID interpreter that is included in an application. A storage structure or element is not an application as used in either Claim 1 or in Ashizawa. Thus, Claim 1 distinguishes over Ashizawa for multiple reasons, only one of which is needed to overcome the anticipation rejection. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claim 1.

Claims 2 to 19 depend from Claim 1 and distinguish over Ashizawa for at least the same reasons as Claim 1. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of each of Claims 2 to 19.

Claim 20 is to a smart card that includes limitations similar to those discussed above with respect to Claim 1. Thus, the above remarks with respect to Claim 1 are applicable to Claim 20 and are incorporated herein by reference. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claim 20.

Claims 21 to 32 depend from Claim 20 and distinguish over Ashizawa for at least the same reasons as Claim 20. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of each of Claims 21 to 32.

Claim 33 also is to a smart card that includes limitations similar to those discussed above with respect to Claim 1. Thus, the above remarks with respect to Claim 1 are applicable to Claim 33 and are incorporated herein by reference.

Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claim 33.

Claim 34 is to a computer program product that includes a method equivalent to that of Claim 1. Thus, the above remarks with respect to Claim 1 are applicable to Claim 34 and are incorporated herein by reference. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claim 34.

Claims 35 to 52 depend from Claim 34 and distinguish over Ashizawa for at least the same reasons as Claim 34. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of each of Claims 35 to 52.

Claims 1 to 52 remain in the application. Claims 1, 20, 33 and 44 have been amended. For the foregoing reasons, Applicant(s) respectfully requests allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on July 17, 2006.



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July 17, 2006

Date of Signature

Respectfully submitted,



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